

Remarks/Arguments:

This Amendment adds no new claims, and is provided to amend claims 1 and 3 only. No new matter has been added. Upon entry of this Amendment, claims 1-60 will be pending. Claims 1, 3 and 57 are independent.

Miscellaneous

The Examiner is requested to provide formal notation of the acknowledgement of receipt of all certified copies of the priority documents. As noted in the previous Office Action of August 8, 2008, boxes 12 and 12(a) are checked, but none of boxes 12(a)(1), 12(a)(2), or 12(a)(3) were checked. Accordingly, the Examiner is requested to provide an Office Action Summary with the next communication in which boxes 12, 12(a), and 12(a)(1) are checked to provide complete acknowledgement.

Rejections of the Claims under 35 U.S.C. 103

The Examiner has maintained the rejection of claims 1-3, 5, 9, 12-17, 19-24, 28-29, 32, 36, 39-44, 46-51, 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0001704 of Chan et al. (hereinafter Chan) in view of U.S. Patent No. 6,833,848 of Wolff et al. (hereinafter Wolff) and U.S. Patent Publication No. 2003/0048848 of Li et al. (hereinafter Li).

Specifically, the Examiner points to Chan as disclosing an image recording/reproducing apparatus which records and reproduces a plurality of still image files and sound files with respect to a recording medium and provides a display apparatus with a screen of play list indicating sound files being currently reproduced, including a decoder for decoding the still image files and the sound files recorded in the recording apparatus, and a memory for storing the still image files and the sound files as decoded.

The Examiner points to Wolff as disclosing such an image recording/reproducing apparatus further having a main control unit for performing a process operation such that a display menu is displayed in a first predetermined area of the screen of play list, wherein the display menu supports the display apparatus such that the plurality of still image files

recorded in the recording apparatus are alternately displayed, and when the display menu is selected during the reproducing of the sound files stored in the memory, one or more files among the stored still image files are alternately displayed on a second predetermined area of the screen of play list.

The Examiner points to Li as disclosing such an image recording/reproducing apparatus still further having a decoder for decoding and storing the plurality of still image files, such that the plurality of still image files recorded in the recording apparatus are decoded and stored in the memory while the decoder is idle, such that the combination of the Chan, Wolff and Li references purportedly render obvious the system and method as recited by the Applicants in independent claims 1 and 3.

The Examiner first points to Chan as disclosing an image recording/reproducing apparatus which records and reproduces a plurality of still image files and sound files with respect to a recording medium and provides a display apparatus with a screen of play list indicating sound files being currently reproduced, including a display menu for supporting the display apparatus such that the plurality of still image files recorded in the recording apparatus are alternately displayed in a first predetermined area of the screen of play list, a decoder for decoding the still image files and the sound files recorded in the recording apparatus, and a memory for storing the still image files and the sound files as decoded.

As noted by the Applicants' earlier response, the Chan reference describes a system and method for providing a still image slide show with background audio. To do so, the system and method is provided to read video and audio data from a storage media, and present the data via a slide show with background audio as selected by a user. Specifically, the display of the Chan reference is configured such that the user can select the association between the slide show and background audio, even in the case of random association (see paragraph 37 and Fig. 6).

However, the Applicants recite a system and method wherein a screen of play list is provided with at least a first and second predetermined area, such that the display menu is provided in the first predetermined area of the screen of play list, and one or more files among the stored still image files are alternately displayed as commanded on the second

predetermined area of the screen of play list (see for example, Applicants' Fig. 44, wherein the buttons 2110 occupy a first predetermined area of the screen of play list and the slide show window 2120 occupies a second predetermined area of the screen of play list). The Examiner notes that Chan does not disclose such a system and method for the display of the one or more files among the stored still image files on a second predetermined area of the screen of play list.

Accordingly, the Examiner points to Wolff as disclosing such an image recording/reproducing apparatus further having a main control unit for performing a process operation such that the display menu (as allegedly described by the Chan reference) is displayed in a first predetermined area of the screen of play list, and the alternate display of the one or more files among the stored still image files on a second predetermined area of the screen of play list.

The Wolff reference describes a system and method for storing, authoring and viewing various forms of digital media. To do so, the system and method provides for the receipt of a media, such as a media card, and the display of one or more media objects in a reduced visual representation (see Abstract). A first display area is provided at a top of a screen to show images for browsing and navigating (see 102, Fig. 1), and a second display area is provided at a bottom of a screen to show an enlarged image of a selected item of the first display area (see 103, Fig. 1). The third display area shows audio narrations that are available for the display of the second area (see 104, Fig. 1).

The Applicants recite a system and method wherein the first predetermined area of the screen of play list indicates an area for displaying a display menu for supporting the display such that the plurality of still image files recorded in the recording apparatus are alternately displayed. That is, the first predetermined area is an area for displaying a menu for executing a slide show, and the second predetermined area of the screen of play list is an area for showing still image files as such a slide show. For example, the Applicants' Fig. 44 illustrates one example of the first predetermined area, that is, the area of the slide show button 2110, and illustrates one example of the second predetermined area, that is, the area of the reference numeral 2120.

The Examiner made the earlier assertion that such a screen of play list and at least the first predetermined area thereof are described by the disk information area of Fig. 6 of Chan, and that such a second predetermined area thereof is described by at least one area of the Wolff reference, such as the area 103 in Fig. 1 of Wolff. However, the disk information display in Fig. 6 of Chan is an area for displaying files included on a disk, such as still images and audio files, and a play mode that is currently being implemented (see Chan Fig. 6), whereas the exemplary screen of play list recited by the Applicants in claim 1 describe the display of the sound file being played, and the first predetermined area recited by the Applicants in claim 1 describes an area for displaying a display *menu*, that is for example, the “repeat all” button, and the “slide show” button, to command the alternate display of the plurality of still image files. Specifically, the disk information display in Fig. 6 of Chan is an area for displaying information, and not for showing the sound file being played or for providing a menu. A play mode which can set an association between images and audio (see paragraph 37) is described as being set using the remote control, user interface, or both (see paragraph 36). However, there is no currently played sound file information, or menu or menu setting feature, in the display of Fig. 6 of Chan. Accordingly, the Applicants assert that the disk information area of Fig. 6 of Chan does not describe the screen of play list and the first predetermined area thereof as recited by the Applicants.

In addition, Fig. 1 of Wolff shows still images, but fails to show or describe the second predetermined area displayed to show the *alternating* images as commanded by the display menu. That is, the Applicants recite a system and method wherein the second predetermined area of the screen of play list shows the plurality of alternating still images, together with the play list, so that the user can identify which image is displayed when a sound file on the play list is reproduced. Such a system and method allows the user to easily identify a still image corresponding to the play list by displaying the still image on the screen of the play list.

However, the Wolff reference fails to describe such a feature of the second predetermined area as recited by the Applicants. Specifically, the area 102 of Wolff shows the sequential arrangement of images, and the area 103 shows an enlarged image selected

from the area 102. That is, area 103 shows the enlarged image of only the selected image, and is not described as a slide show window. A slide show may be created in the area 103 only through repeated selections of images from area 102. As such, even where the area 103 allegedly describes a predetermined area to show alternating images, the alternating images are not shown as commanded by the concurrently displayed display menu.

In response to the Applicants' above arguments, the Examiner points to the display menu 110 of Wolff as also describing a display menu of a first area, and points to the large image screen display 120 of area 103 of Wolff as describing a second area at which still image files are alternately displayed, concurrently with a play list as allegedly described by the tracks 105, 110 and 115. Further, the Examiner asserts that the distinctive features argued by the Applicants are not recited in the claims.

In response, the Applicants assert that the tracks 105, 110 and 115 are provided to show stored images. As noted above, the system and method of Wolff provides for the receipt of a media, such as a media card, and the display of one or more media objects in a reduced visual representation. The tracks 105, 110 and 115 of the first display area are provided at a top of a screen to show images for browsing and navigating (see also 102, Fig. 1). As such, the Applicants assert that the tracks of area 102 do not provide a display menu, but a display of stored images. The Applicants have amended independent claims 1 and 3 to clarify the provision of a display menu, as shown by way of example at 2110 of Applicants' Fig. 44, as distinguished from the display of stored images from which an image selection can be made as shown by tracks of area 102 of Wolff Fig. 1.

That is, the Applicants have amended independent claims 1 and 3 to recite a system and method for providing a display menu in a first predetermined area of the screen of the play list, wherein the display menu comprises at least one instruction icon to command an alternating display such that the plurality of still image files recorded in the recording apparatus are alternately displayed as commanded. In contrast, the Applicants assert that the tracks 105, 110 and 115 are provided to show images in order of storage, and do not describe an instruction menu or display menu. Further, in the case where the tracks 105, 110 and 115 allegedly describe an instruction menu or a display menu, the instruction is limited to the

selection of a single image for display and therefore, does not describe an instruction menu comprising at least one instruction icon to command an alternating display as recited by the Applicants.

As noted above, the Examiner points to the display menu 110 of Wolff as describing a display menu of a first area, and points to the large image screen display 120 of area 103 of Wolff as describing a second area at which still image files are alternately displayed, concurrently with a play list as allegedly described by the tracks 105, 110 and 115. The Applicants assert that the tracks 105, 110 and 115 are provided to show images for browsing and navigating, and more specifically, are provided to show still image data for such browsing and navigating, and not sound files. Further, in regard to the Chan reference, the Applicants assert that there is no currently played sound file information in the display of Fig. 6 of Chan.

In contrast, the Applicants recite the play list of independent claims 1 and 3 as provided in regard to sound files (see again for example, Applicants' Fig. 44), such that the still image files are alternately displayed concurrently with the play list of sound files. The Applicants have amended independent claims 1 and 3 to clarify the exemplary embodiment as recited wherein the stored still image files are alternately displayed as commanded on the second predetermined area of the screen of play list to serve as indication of the sound files of the play list as concurrently shown.

For these reasons, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3 as amended, and respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a).

Regarding dependent claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56, the Examiner, in addition to the reasons stated above, further points to Wolff and Chan as disclosing subject matter of each, purportedly anticipating the system and method as recited by the Applicants.

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3 as amended, from which claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 2, 5, 9, 12-17, 19-24, 28, 29, 32, 36, 39-44, 46-51, 55 and 56 for the same reasons.

The Examiner has also maintained the rejection of claims 4, 30 and 31 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0033889 of Miyazaki (hereinafter Miyazaki) and has maintained the rejection of claims 6 and 33 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2001/0056434 of Kaplan et al. (hereinafter Kaplan).

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3 as amended, from which claims 4, 6, 30, 31 and 33 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 4, 6, 30, 31 and 33 for the same reasons.

The Examiner has also maintained the rejection of claims 7 and 34 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0136539 of Nakaya (hereinafter Nakaya) and has maintained the rejection of claims 8 and 35 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0012522 of Kawakami et al. (hereinafter Kawakami).

The Examiner has also maintained the rejection of claims 10, 11, 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2003/0123853 of Iwahara et al. (hereinafter Iwahara), and has maintained the

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rejection of claims 18 and 45 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent No. 7,315,389 of Kuwata et al. (hereinafter Kuwata).

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3 as amended, from which claims 7, 8, 10, 11, 18, 34, 35, 37, 38 and 45 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 7, 8, 10, 11, 18, 34, 35, 37, 38 and 45 for the same reasons.

The Examiner has also maintained the rejection of claims 25 and 52 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2002/0141580 of Okuyama (hereinafter Okuyama), and has maintained the rejection of claims 26 and 53 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent Publication No. 2001/0055465 of Inoue (hereinafter Inoue). The Examiner has also maintained the rejection of claims 27 and 54 under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Wolff, Li and U.S. Patent No. 5,969,719 of Tsujimoto (hereinafter Tsujimoto).

However, for the reasons stated above, the Applicants assert that the Wolff, Chan and Li references do not disclose or reasonably suggest, separately or in combination, each element as recited by the Applicants in independent claims 1 and 3 as amended, from which claims 25-27 and 52-54 depend. Accordingly, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a) of dependent claims 25-27 and 52-54 for the same reasons.

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Conclusion

In view of the above, it is believed that the application is in condition for allowance and notice to this effect is respectfully requested. Should the Examiner have any questions, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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